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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/599,498	09/29/2006	Kevin Taylor	CCY1 0140 PUSA	9858
71867 7590 03/17/2009 BANNER & WITCOFF, LTD ATTORNEYS FOR CLIENT NUMBER 007412 1100 13th STREET, N.W. SUITE 1200 WASHINGTON, DC 20005-4051				
EXAMINER SHEPARD, JUSTIN E				
ART UNIT 2424		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/599,498

Applicant(s)

TAYLOR ET AL.

Examiner

Justin E. Shepard

Art Unit

2424

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SG/US)
Paper No(s)/Mail Date 1/26/09
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 12/19/08 have been fully considered but they are not persuasive.

Page 6:

The applicant argues that Addington does not disclose the newly added limitations. The examiner agrees and will be using a new grounds of rejection to address the new limitations.

Page 7, last paragraph:

The applicant argues that Eshun fails to teach storing STB certification information in the provisioning datastore, but instead discloses storing an authentication certificate in a customer premises telephone device. Referring to figure 2 of Eshun, the system installs a Pre-Provisioning Contact on the device itself (a telephone) and a Provisioning Contact on the Pre-Provisioning server (paragraphs 59 and 60). Later when the telephone is connected to the network, this stored data is used for directing the telephone to the Pre-Provisioning Server and tells the server to activate the telephone (paragraphs 61, 62 and 63). This is interpreted as installing certificate information on a provisioning datastore. As for the device not being a STB, the examiner feels that a system for authorizing a telephone and a separate system for authorizing a STB would be analogous and therefore would be able to use parts and components from each.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 6, 7, 8, 12, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Addington in view of Eshun.

Referring to claim 1, Addington discloses a method of provisioning a set-top box (STB) with a STB provisioning system including a service provisioning system, a billing system, a conditional access system, a video device manager, and a provisioning datastore (figure 19), the method comprising:

storing STB profile information in the provisioning datastore (paragraph 236; figure 20a, step 5);

receiving a customer order at the service provisioning system (figure 20A; steps 4 and 5) independent of the conditional access system (figure 24; Note: as all the authorization for music downloading is sent and received through the ESS and not the conditional access system, this is interpreted as being an order placed independently of that system);

notifying the billing system of the customer order (paragraph 236);

transmitting a notification of the customer order to the conditional access system, the notification communicating customer desired cable operator services (figure 20A, step 5; paragraph 235);

storing information from the customer order in the provisioning datastore (paragraph 236);

notifying the video device manager about the STB (paragraph 236); and

delivering a cable operator configuration message from the video device manager to the STB (figure 20B, step 19), the configuration message being based on information from the provisioning datastore, thereby provisioning the STB without essential involvement of the conditional access system (figure 20B, step 11).

Addington does not disclose a method for receiving STB profile information independent of the conditional access system.

In an analogous art, Eshun teaches a method for receiving STB profile information independent of the conditional access system (figure 24).

At the time of the invention, it would have been obvious for ordinary skill in the art to add the factory set provisioning information taught by Eshun to the system disclosed by Addington. The motivation would have been to allow the system to be quickly authorized after purchasing the device.

Referring to claim 2, Addington does not disclose a method of claim 1 further comprising: storing STB certification information in the provisioning datastore.

In an analogous art, Eshun teaches a method of claim 1 further comprising:
storing STB certification information in the provisioning datastore (paragraph 58).

At the time of the invention, it would have been obvious for one of ordinary skill in the art to add the STB certificate taught by Eshun to the method disclosed by Addington. The motivation would have been to enable the system to restrict access to specific information (Addington: paragraph 233).

Referring to claim 6, Addington discloses a method of claim 1 wherein transmitting a notification of the customer order to the conditional access system is performed by the billing system (figure 20A, step 5).

Referring to claim 7, Addington discloses a method of claim 1 wherein transmitting a notification of the customer order to the conditional access system is performed by the service provisioning system (figure 20A, step 5).

Referring to claim 8, Addington discloses a method of claim 1 wherein the STB provisioning system further includes a data device manager, the method further comprising: notifying the data device manager about the STB (figure 20A, step 5).

Referring to claim 12, Addington discloses a method of claim 1 wherein the configuration message is sent using bi-directional unicast messaging (paragraph 106).

Referring to claim 13, Addington discloses a method of claim 1 wherein the configuration message is sent using uni-directional multicast messaging (paragraph 106).

Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Addington and Eshun as applied to claims 1 and 2 above, and further in view of Steenkamp.

Referring to claim 3, Addington and Eshun do not disclose a method of claim 2 further wherein the STB certification information is instantiated as an XML formatted document.

In an analogous art, Steenkamp teaches a method of claim 2 further wherein the STB certification information is instantiated as an XML formatted document (paragraph 123).

At the time of the invention, it would have been obvious for one of ordinary skill in the art to add the XML message protocol taught by Steenkamp to the method disclosed by Addington and Eshun. The motivation would have been to use an available protocol to save on development costs.

Referring to claim 4, Addington and Eshun do not disclose a method of claim 1 wherein the STB profile information is instantiated as an XML formatted document.

In an analogous art, Steenkamp teaches a method of claim 1 wherein the STB profile information is instantiated as an XML formatted document (paragraph 123).

At the time of the invention, it would have been obvious for one of ordinary skill in the art to add the XML message protocol taught by Steenkamp to the method disclosed by Addington and Eshun. The motivation would have been to use an available protocol to save on development costs.

Claims 5 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Addington and Eshun as applied to claim 1 above, and further in view of Cochran.

Referring to claim 5, Addington and Eshun do not disclose a method of claim 1 wherein the customer order is instantiated as an XML document.

In an analogous art, Cochran teaches a method of claim 1 wherein the customer order is instantiated as an XML document (column 11, line 65 to column 12, line 9).

At the time of the invention, it would have been obvious for one of ordinary skill in the art to add the XML message protocol taught by Cochran to the method disclosed by Addington and Eshun. The motivation would have been to use an available protocol to save on development costs.

Referring to claim 9, Addington and Eshun do not disclose a method of claim 1 wherein the configuration message to the STB is instantiated as an XML document.

In an analogous art, Cochran teaches a method of claim 1 wherein the configuration message to the STB is instantiated as an XML document (column 11, line 65 to column 12, line 9).

At the time of the invention, it would have been obvious for one of ordinary skill in the art to add the XML message protocol taught by Cochran to the method disclosed by Addington and Eshun. The motivation would have been to use an available protocol to save on development costs.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Addington and Eshun as applied to claim 1 above, and further in view of Jost.

Referring to claim 10, Addington and Eshun do not disclose a method of claim 1 wherein the configuration message to the STB includes configuration of the STB geographical location.

In an analogous art, Jost teaches a method of claim 1 wherein the configuration message to the STB includes configuration of the STB geographical location (column 9, line 64 to column 10, line 7).

At the time of the invention, it would have been obvious for ordinary skill in the art to add the location message taught by Jost to the method disclosed by Addington and Eshun. The motivation would have been to enable the device to not be installed in areas where it would be prohibited.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Addington and Eshun as applied to claim 1 above, and further in view of Freeman.

Referring to claim 11, Addington and Eshun do not disclose a method of claim 1 wherein the configuration message to the STB includes configuration to enable multiple channel lineups.

In an analogous art, Freeman teaches a method of claim 1 wherein the configuration message to the STB includes configuration to enable multiple channel lineups (paragraph 54).

At the time of the invention, it would have been obvious for ordinary skill in the art to add the multiple channel lineups taught by Freeman to the method disclosed by Addington and Eshun. The motivation would have been to enable more viewing options to be provided to the users.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Addington and Eshun as applied to claim 1 above, and further in view of Rakib.

Referring to claim 14, Addington and Eshun do not disclose a method of claim 1 wherein the configuration message is sent in response to a boot-time request from the STB.

In an analogous art, Rakib teaches a method of claim 1 wherein the configuration message is sent in response to a boot-time request from the STB (paragraph 6).

At the time of the invention, it would have been obvious for one of ordinary skill in the art to add the boot-time configuration taught by Rakib to the method disclosed by Addington and Eshun. The motivation would have been to enable the device to be moved to another location and still function on the network.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Justin E. Shepard whose telephone number is (571) 272-5967. The examiner can normally be reached on 7:30-5 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Chris Kelley/
Supervisory Patent Examiner, Art
Unit 2424

JS